

## **REMARKS**

This Application has been carefully reviewed in light of the Non-Final Office Action mailed July 15, 2008. At the time of the Office Action, Claims 1-20 were pending and rejected in this Application. Applicants respectfully request reconsideration and favorable action in this case.

### **Priority**

The Office Action states that Applicant has not complied with the conditions of 35 USC 119(c) for receiving the benefit of an earlier filing date. Applicant traverses this contention to the extent the Office considers that Applicant's claim for benefit of an earlier filing date for the claimed subject matter of the present application does not comport with the effective filing date of International Application No. PCT/US02/29476. Accordingly, Applicant contends that the claimed subject matter of the present application should receive the benefit of the September 14, 2001 filing date of U.S. Provisional Application No. 60/322,243. The present application is a continuation of and claims priority to International Application No. PCT/US02/29476, which derives priority from U.S. Provisional Application No. 60/322,243. Applicant has amended the claim for benefit in the specification to reflect the priority claim to the '243 Application. To the extent that the present application discloses and claims the subject matter disclosed in the '243 and '476 Applications, Applicant submits that the claim for benefit of the earlier filing dates of these prior filed applications inures to the present application.

The '243 and '476 Applications are a continuation-in-part of U.S. Patent Application No. 09/586,295. Applicant agrees that the '295 Application fails to provide adequate support or enablement for one or more claims of the present application. Applicant respectfully points out that because the '243 and '476 Applications are a continuation-in-part of the '295 Application, those applications "disclose and claim subject matter not disclosed in the prior application" and name "an inventor not named in the prior application" in accordance with 37 CFR 1.78(b)(2). Because the present application is a continuation of a CIP application and therefore discloses and claims subject matter not disclosed in the prior '295 Application, the prior filed '295 Application *et al* is not required to provide adequate support or enablement for the claims of the present application.

**Rejections under 35 U.S.C. § 102**

Claims 1-20 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0183739 by Long (“Long”). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “the identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the art cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

With regard to claims 1 and 20, Long describes an endoscopic ablation system having an ablation cap at its distal end, the ablation cap including a rigid support member having a plurality of electrodes positioned on its outside surface. In certain embodiments, the ablation cap may include an opening that allows fluid communication between the endoscope and tissue around the ablation cap. However, the opening identified as the suction opening found in Long is not disposed on the body of the electrode, as is recited by claims 1 and 20. Rather, the suction opening is described as being positioned on the insulative ablation cap or rigid support member, and more specifically described as on the side of the rigid support member opposing the position of the electrodes. Moreover, the opening described by Long is sized such that instruments may access tissue through the opening. Additionally, the electrodes described by Long do not themselves have a lumen therethrough. Rather, the electrodes (28) described by Long are relatively planar, having a low profile and shaped to complement a circular cylindrical shaped ablation cap. See Fig. 3 below:

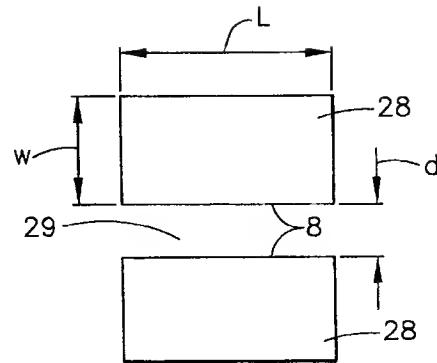


FIG. 3

For at least these reasons, Long does not teach all of the elements of claims 1 and 20 and therefore cannot anticipate claims 1 and 20. Applicant submits that claims 1 and 20 are in condition for allowance, and requests withdrawal of the rejection.

Claims 2-19 depend directly or indirectly from claim 1. Applicant hereby repeats and incorporates the above comments made with regard to claim 1. For at least these reasons, Applicant submits that claims 2-19 are in condition for allowance and requests withdrawal of the rejection.

**Information Disclosure Statement**

Applicants enclose an Information Disclosure Statement and PTO Form 1449, with copies of the references for the Examiner's review and consideration.

## CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

The Commissioner is hereby authorized to charge \$180 for the IDS to Deposit Account No. 50-0359 of ArthroCare Corporation. Applicant believes there are no additional fees due at this time, however, the Commissioner is hereby authorized to charge any additional fees necessary or credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.358.5925.

Respectfully submitted  
Attorney for Applicants,



Matthew Scheele  
Reg. No. 59,847

Date: 10/8/08

SEND CORRESPONDENCE TO:  
ARTHROCARE CORPORATION  
CUSTOMER NO. **21394**  
512.358.5925  
512.391.3901 (fax)

Enclosure: 1) Information Disclosure Statement and PTO Form 1449, with copies of the references.